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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,305	11/08/2001	Bruno Borsoi	P21570	5187
7055	7590	12/28/2004	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			PHAM, HUONG Q	
			ART UNIT	PAPER NUMBER
			3764	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,305

Applicant(s)

BORSOI, BRUNO

Examiner

Huong Q. Pham

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/20/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 13-40 is/are pending in the application.
- 4a) Of the above claim(s) 10-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 13-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 8-9, 14, 16, 19- 24, 27- 35, 38-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Dachgruber et al (6,360,454). As for claims 1, 8-9, 14, 19 , 30, 35, 40, Dachgruber et al shows every claimed feature of the claims including a rigid frame 24 (figures 1, 3), one bending zone with an abutment 100 , or 102 , or 98 . It appears that the aperture 100, or the notches 98, or the element 102 has abutting surfaces (for element 102, when device 24

Art Unit: 3764

is bent at certain degree, abutting surfaces will be the side surface of element 102 and the surface of device 24 which is adjacent to the side surface of element 102), and when the device 24 of Dachgruber et al is flexed at certain degree, the abutting surfaces function to limit flexion to some degree. Note that "rigid " is a relative term. A material appears to be " rigid " to one person might appear to be " flexible" to another. As for claims 16, 29, note column 4, lines 6-7. As for claims 20, 21 , 31 –32, note notch 98. As for claims 22, 33, note abutment 100 within the bending zone , and compressible insert 102 positioned within notch 100. As for claims 23, 34, note abutment 98 comprises a notch. As for claim 24, note that "rigid " is a relative term. As for claims 27, 38, note shock absorbing element 102, 22. As for claims 28, 39, note shock absorbing element 102, 22 positioned within pocket 45.

Claims 3, 5-7, 18 –21, 23- 36, 38-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Filice (6,381,877). As for claims 3, 18, 25, 36, Filice shows every claimed feature of the claims including a rigid frame 23, 22, 24, 25, 26 (FIGURE 5) with a bending zone 26 having an abutment 28, 46, rigid frame 23, 22, 24, 25, 26 is fixed to an inextensible membrane (by means 29 : note figure 5). As for claim 5, note notches at zone 26, and note that the bending zone 26 is thicker than supports 22, 24. As for claim 6 –7, note in figures 4, 4a the shock absorbing element 25 is positioned in a pocket affixed to an envelope (note in figure 5 that frame 22, 24 is affixed to an envelope). As for claims 19 –21, 23- 40, note the comments relative to the claims above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dachgruber et al in view of Ottieri or Dodge et al. Ottieri and Dodge et al teach beveled notches for a footwear. In view of the teaching of Ottieri or Dodge et al , it would have been obvious to an ordinary skill in the art at the time the invention was made to provide a beveled notch for the footwear of Dachgruber et al to achieve the desired degree of flexibility. The shape of a notch, i.e., a beveled notch for a protective article for a joint, is well-known in the art, and does not provide any unobvious result, and therefore is not patentable over prior art. As for claim 4, note insert 102.

Claims 13, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dachgruber et al in view of Gray et al, or Mcquaid et al, or Filice. As for claim 13, Gray et al and Mcquaid et al teach a boot tightening means and a cooperating mechanism for a footwear as recited. In view of the teaching of Gray et al or Mcquaid et al , it would have been obvious to an ordinary skill in the art at the time the invention was made to provide these structure for the footwear of

Art Unit: 3764

Dachgruber et al to firmly secure the frame 24 to the footwear. As for claim 15, the provision of a recess in a shell of a footwear for accommodating toes of a wearer is well known in the art, and therefore is not patentable over prior art.

Claims 17, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Filice in view of Dachgruber et al or Perotto et al (5,050,319). Filice teaches bending zone 26 which is narrower than one support 24. Dachgruber et al and Perotto et al teach a bending zone which is narrower than two supports. In view of the teaching of Dachgruber et al or Perotto et al , it would have been obvious to an ordinary skill in the art at the time the invention was made to provide the device of Filice with two supports which are wider than the bending zone in order to provide more support at the upper and lower area of the ankle.

Applicant's arguments filed on 9/20/04 have been fully considered but they are not persuasive. Applicant argues that there is no abutment in a bending zone of Dachgruber et al to limit further flexion of the stiffener. The examiner disagrees. Note the comments relative to the claims above for the teaching of Dachgruber (note abutment 100, 102, or 98 of Dachgruber et al). It appears that the aperture 100, or the notches 98, or the element 102 has abutting surfaces (for element 102, when device 24 is bent at certain degree, abutting surfaces will be the side surface of element 102 and the surface of device 24 which is adjacent to the side surface of element 102), and when the device 24 of Dachgruber et al is flexed at certain degree, the abutting surfaces function to limit

Art Unit: 3764

flexion to some degree. Applicant argues that Ottieri and Dodge do not teach or suggest an abutment to limit flexion. Note that any notch or beveled notch will have abutment surfaces which have abutting function (at certain degree of flexion) and therefore limiting some degree of flexion .

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

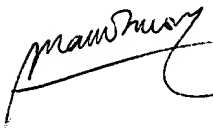
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huong Q. Pham whose telephone number is (571) 272-4980. The examiner can normally be reached on 6:30 AM - 3:00 PM.

Art Unit: 3764

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272 - 4835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 17, 2004


JUSTINE R. YU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

12/23/04